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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,905	06/30/2005	Peter C. Brazier	9236A	2409
25280	7590	09/05/2008		
Legal Department (M-495)			EXAMINER	
P.O. Box 1926			TOLIN, MICHAEL A	
Spartanburg, SC 29304				
		ART UNIT	PAPER NUMBER	
		1791		
		MAIL DATE	DELIVERY MODE	
		09/05/2008	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/516,905

Applicant(s)

BRAZIER ET AL.

Examiner

MICHAEL A. TOLIN

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-36, 40, 41, 43, 45, 46, 48-52, 54, 55, 57, 59-63, 65-69, 71 and 72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-36, 40, 41, 43, 45, 46, 48-52, 54, 55, 57, 59-63, 65-69, 71 and 72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 32-36, 40, 41, 43, 45, 46, 48-52, 54, 55, 57, 59-63, 65-69, 71 and 72 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 32, there is no indication in the specification that the claimed deformability range of 14-50% may be achieved when pressing in the claimed range of 2-8 psi. In particular, Applicant's Table 3 on page 16 of the specification clearly indicates that pressures of 2-8 psi result in a deformability of approximately 14-25%. Accordingly, it does not appear Applicant possessed the limitation of achieving a deformability above the range of 14-25% when pressing in the claimed range of 2-8 psi. The examiner suggests limiting the claimed range of deformability to about 14-25%.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 32-36, 40, 41, 43, 45, 46, 48-52, 54, 55, 57, 59-63, 65-69, 71 and 72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 32, the term "deformability" does not have a clear meaning. In particular, claim 32 does not clearly establish the conditions by which deformability is determined. The specification indicates the conditions by which deformability is determined (page 15, lines 16-19; page 16, lines 1-2). However, the specification does not clearly define deformability in terms of these conditions. One of ordinary skill in the art might read the test conditions for determining deformability which are described in the specification as merely exemplary. Accordingly, the intended scope of the claimed term "deformability" is not entirely clear from the language of claim 32. The examiner suggests adding language to claim 32 to indicate the conditions under which deformability is determined, for example those conditions described in the above noted portion of Applicant's specification.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 32-36, 40, 41, 43, 45, 46, 48-52, 54, 55, 57, 59-63 and 65-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crenshaw (WO 03/014462 A1) in view of Vorel (WO 96/22413 A1, referencing attached machine translation), Allen (US 3801421), Newbould (EP 0367441 A2), Ashton (US 5057175), Pourmand (US 6342115) and Hutter (US 3005230).

The claims are rejected for the reasons provided in numbered paragraphs 3 and 4 of the previous office action mailed 30 January 2008.

Regarding the new limitation of a deformability of about 14-50%, Applicant's specification clearly explains that the claimed deformability is the result of the presence of voids between the crumbs (page 4, lines 3-5). The specification further explains that there is a correlation between the bonding pressure and the deformability (page 16, lines 5-8). In examining Applicant's Table 3 on page 16 of the specification, it is seen that the claimed deformability range is achieved at applied pressures of approximately 0-8 psi. Since motivation was provided for applying pressure within this range, as set forth in numbered paragraph 3 of the previous office action, it naturally follows that deformability within the claimed range will be inherently achieved in the modified

process of Crenshaw. No objective evidence or arguments to the contrary have been provided.

7. Claims 48, 49, 71 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crenshaw in view of Vorel, Allen, Newbould, Ashton, Pourmand and Hutter as applied to claims 32-36, 40, 41, 43, 45, 46, 48-52, 54, 55, 57, 59-63 and 65-69 above, and further in view of Kerr (US 5932317).

The claims are rejected for the reasons provided in numbered paragraph 5 of the previous office action mailed to 30 January 2008.

Response to Arguments

8. Applicant's arguments filed 30 June 2008 have been fully considered but they are not persuasive.

Applicant argues that the limitation of pressing in a heated press having an inflatable diaphragm and a single heated platen having a low temperature zone and a high temperature zone has not been satisfied. In particular, Applicant argues that Newbould cannot be combined with Crenshaw because the apparatus described by Crenshaw is incapable of having an inflatable diaphragm. In response, Crenshaw indicates that pressure may be applied using a variety of molding machines and mold types and further suggests the use of a continuous method wherein rubber particles are deposited on a conveyor (paragraphs 47 and 49). Newbould was applied for teaching a specific example of such an apparatus for manufacturing rubber-backed mats or carpet.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant argues that the claimed density range of 0.5-0.9 g/cm³ has not been satisfied because such densities are not taught by the primary reference to Crenshaw. Crenshaw was not relied upon for teaching the claimed density range. As set forth in numbered paragraph 3 of the previous office action, Vorel and Allen were cited to provide motivation to apply pressures within the claimed range thereby achieving densities within the claimed range. Specifically, Vorel and Allen suggest such densities and pressures in order to produce a rubber crumb layer having voids which provide the mat with suitable water permeability. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that the limitation of providing voids has not been satisfied. This argument is not persuasive for the reasons provided above.

Applicant argues that Crenshaw teaches away from voids because Crenshaw utilizes high pressure which eliminates voids. The examiner disagrees. Crenshaw is directed to applying a wide range of pressure including pressures within the claimed range (approximately 5-500 psi). See Crenshaw, paragraph 51. Vorel was applied, as

noted above, to suggest using pressures at the lower end of this range in order to achieve water permeability by producing a mat with voids. The examiner does not find any teaching in Crenshaw that voids are to be eliminated or that voids must be eliminated. Only the expected result of producing a mat with voids by using a suitably low applied pressure has been achieved.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL A. TOLIN whose telephone number is (571)272-8633. The examiner can normally be reached on M-F 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael A Tolin/
Patent Examiner, Art Unit 1791